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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,216	06/22/2001	Veronique Guillou	209310US0	8029

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

WANG, SHENGJUN

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/886,216

Applicant(s)

GUILLOU ET AL.

Examiner

Shengjun Wang

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Receipt of the appeal brief submitted May 12, 2003 is acknowledged.

The finality of the office action mailed September 10, 2002 is withdrawn in favor of the following rejection.

Claim Rejections 35 U.S.C. 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants does not provide sufficient written description in such way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession a composition comprising a surfactant system in an aqueous medium, wherein said surfactant system exhibits at least one paracrystalline phase selected from the group consisting of direct hexagonal phase, cubic phase, and mixtures thereof, *only* when the temperature increases immediately above 30 °C and remains present up to 45 °C. Such subject matter is encompassed by the claimed invention. Specifically, the specification discloses that the composition may comprise 10-50% by weight, preferably, 15-35% by weight of water soluble surfactant, and 5-50 %, preferably 5-30% of water-insoluble surfactant; and the 20 to 65%, preferably 30 to 65 % by weight of total surfactants (pages 9-11). In the example of Invention,

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the composition comprises 29.5% of water soluble surfactant, and 12.5% of water insoluble surfactant. The comparative example comprises 14% of water-soluble surfactants, and 21.15 of water insoluble surfactants. Note both examples are within the disclosed range. The specification provides no guidance, direction, as to how to successfully make claimed invention, particularly, a composition that exhibits at least one paracrystalline phase selected from the group consisting of direct hexagonal phase, cubic phase, and mixtures thereof, *only* when the temperature increases immediately above 30 °C and remains present up to 45 °C. Note the examples exhibit the crystalline phase exhibits only at 35 °C. Not description is provided that the crystalline phase would exhibits at below 35 °C and above 30 °C.

3. Claims 1-27 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the composition as disclosed in the example, does not reasonably provide enablement for any other compositions, which would meet the limitation herein defined. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

4. The instant specification fails to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation. Attention is directed to *In re Wands*, 8 USPQ 2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factor to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApls 1986) at 547 the court recited eight factors:

- 1) the quantity of experimentation necessary,
- 2) the amount of direction or guidance provided,

- 3) the presence of absence of working examples,
- 4) the nature of the invention,
- 5) the state of the prior art,
- 6) the relative skill of those in the art,
- 7) the predictability of the art, and
- 8) the breadth of the claims.

5. The claim drawn to a surfactant system defined only by its physical properties, however, the specification fails to provide sufficient guidance, direction, or working examples to enable one of skilled artisan to make and use the claimed invention. Applicants fail to provide information allowing skilled artisan to ascertain these compounds without undue experimentation. In the instant case, the specification provide very limited amount of direction or guidance. Particularly, the specification discloses that the composition may comprise 10-50% by weight, preferably, 15-35% by weight of water soluble surfactant, and 5-50 %, preferably 5-30% of water-insoluble surfactant; and the 20 to 65%, preferably 30 to 65 % by weight of total surfactants (pages 9-11). In the example of Invention, the composition comprises 29.5% of water-soluble surfactant, and 12.5% of water insoluble surfactant. The comparative example comprises 14% of water-soluble surfactants, and 21.15 of water insoluble surfactants. Note both examples are within the disclosed range. The specification provides no guidance, direction, as to how to successfully make claimed invention.

Claim Rejections 35 U.S.C. 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-7 and 9-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Lance-Gomez (US Patent 6,007,769, of record).

Lance-Gomez discloses soap-based composition for use in cleaning and air fragrancing products. The soap system is thermally stable up to 80 oC (see col. 1, lines 64-65). The composition form stable liquid crystalline in water with a surfactant (see, col. 3, line 60 through col. 4, line 5). Hexagonal phase are present at 60 oC and 80 oC for various compositions (see col. 10, lines 5-45 and fig. 4-10). The systems also exhibit lamellar phases (see col. 10, lines 5-45). While the reference is silent with respect to modulus and lose angle, it is the position of the examiner that the properties are inherent to the compositions. Lance-Gomez discloses that nonionic surfactant can be present in an amount from 0.5% to about 20%. Nonionic surfactant include ethoxylated C12-C14 fatty alcohols with long or short chain ethylene oxide, meeting the limitation of both water-soluble and water insoluble surfactants (see, col. 5, lines 24-43). The compositions may further comprise anionic surfactant (see col. 6, lines 44-46). Alkyl sulfate and alkyl ether sulfates such as lauryl sulfate and lauryl ether sulfate are disclosed as anionic surfactants, wherein the anionic surfactants are present in the amount from 0 to about 15% by weight. Fatty acid soaps are disclosed in amounts from 0.1 to about 90% of the composition (see col. 4, lines 6-28). Additional solvents including isopropanol are disclosed (see col. 5, line 59 through col. 6, line 3). The limitation of “further comprising at least one thickening agent” in

claim 18 is met by the use of fatty acid, as Lance-Gomez teaches that the addition of fatty acid results in viscous liquids or a rubbery gel (see col. 1, lines 54-63).

8. Claims 21, 23, 25 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Hawkins (EP 0598 335, of record).

9. Hawkins discloses method for the use of aqueous based surfactant compositions as cleaning compositions, particularly for use in cleaning human skin (see page 7, lines 5-10, and lines 27-28) the compositions are described as "VI phase" which means they have a cubic phase (see page 6, lines 27-39, page 13, claim 18). The surfactants are chose such that the VI phase melts at a temperature above 40oC and below 100 °C (see page 8, lines 8-11).

Claim Rejections 35 U.S. C. 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-22, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lance-Gomez et al. (US Patent 6,007,769, of record) in view of Rosser (EP 0 339 994).

Lance-Gomez discloses soap-based composition for use in cleaning and air fragrancing products. The soap system is thermally stable up to 80 °C (see col. 1, lines 64-65). The composition form stable liquid crystalline in water with a surfactant (see, col. 3, line 60 through col. 4, line 5). Hexagonal phase are present at 60 °C and 80 °C for various compositions (see col. 10, lines 5-45 and fig. 4-10). The systems also exhibit lamellar phases (see col. 10, lines 5-45).

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Lance-Gomez discloses that nonionic surfactant can be present in an amount from 0.5% to about 20%. Nonionic surfactant includes ethoxylated C12-C14 fatty alcohols with long or short chain ethylene oxide, meeting the limitation of both water-soluble and water insoluble surfactants (see, col. 5, lines 24-43). The compositions may further comprise anionic surfactant (see col. 6, lines 44-46). Alkyl sulfate and alkyl ether sulfates such as lauryl sulfate and lauryl ether sulfate are disclosed as anionic surfactants, wherein the anionic surfactants are present in the amount from 0 to about 15% by weight. Fatty acid soaps are disclosed in amounts from 0.1 to about 90% of the composition (see col. 4, lines 6-28). Additional solvents including isopropanol are disclosed (see col. 5, line 59 through col. 6, line 3). The reference lacks teaching additional thickening agents amphoteric surfactants, and method of cleaning skin, scalp or hair.

However, Rosser teaches detergent compositions, Rosser teaches that non-soap detergents, particularly nonionic surfactants can confer mildness to personal washing products (see col. 1, lines 21-50). Rosser also teaches that such products can have a problem with respect to the lowering of viscosity on storage (see col. 1, lines 21-30). As such, Rosser teaches the use of thickening agents for detergent gel compositions (see col. 4, lines 18-36). Further ingredients taught by Rosser include betaines to improve foam, as the addition of soap to liquid detergents is known to inhibit foam formation (see col. 1, lines 40-50; col. 2, lines 38-50).

It would have been prima facie obvious to one of ordinary skill in the art at the time the claimed invention was made, to have modified to composition of Lance-Gomez by the addition of thickening agents and betaines, as well as the use of such composition for washing skin and hair in order to benefit from the compositions with improved foam due to the betaines as well as mildness on skin due to the presence of nonionic surfactants as taught by Rosser.

Response to the Arguments

The remarks presented in the appeal brief have been fully considered, but are not persuasive as discussed below.

12. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., hexagonal crystalline phase is exhibited only after the temperature rise above 30 °C)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Particularly, applicants argue that the cited references provide composition exhibiting the crystalline phase before the temperature reach 30 °C, while the claimed composition only exhibit the phase after temperature reach above 30 °C, and does not exhibit such phase before the temperature reach 30 °C. However, such limitation is not recited in the claims.

13. With respect to Hawkins' teaching, note Hawkins teaches the crystalline is maintained up to above 40 °C and below 100 °C, which met the limitation "up to at least 45 °C."

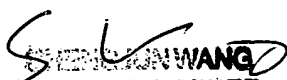
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

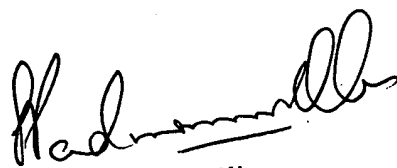
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Patent Examiner


PATENT EXAMINER
Shengrun Wang

July 24, 2003


SREENI PADMANABHAN
PRIMARY EXAMINER
SPE/1617 7/28/03